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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,931	04/14/2004	Chuanfu Wang	BYD-US2003-008	5277

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Venture Pacific Law, PC
5201 Great America Parkway, Suite 270
Santa Clara, CA 95054

EXAMINER
VIJAYAKUMAR, KALLAMBELLA M

ART UNIT	PAPER NUMBER
1793	

NOTIFICATION DATE	DELIVERY MODE
03/03/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@vpaclaw.com
support@vpaclaw.com
quon@vpaclaw.com

Office Action Summary	Application No.	Applicant(s)	
	10/823,931	WANG ET AL.	
	Examiner	Art Unit	
	KALLAMBELLA VIJAYAKUMAR	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *6-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *04/14/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- Applicant's election with *traverse* of Group-I, Claims 1-5 in the reply filed on 04/20/2009 is acknowledged. The traversal is on the ground(s) that the inventions I and II are not different because claim-6 depends upon claim-1, the process is obvious process to make the compound and no materially different process can be used to make the product (Res, Pg-8, Para 1-2). This is not found persuasive because the legal standard for the restriction is whether the process as claimed can be used to make another and materially different product, or the product as claimed can be made by another and materially different process [MPEP 806.05(f)] and the examiner has provided evidence in the office action mailed 9/19/2006 to substantiate that product can be made by other processes. Further, the prior art by Rougier et al clearly teaches a materially different method using a solid state reaction between Li_2CO_3, NiO and Co_3O_4 (Ref used in rejection-1; Pg-85, Cl-2) with out the use of Ni-Co-OH intermediate as claimed in claim-6. Applicant further argues that the search for both groups would not impose a serious burden, since the search for both groups would be in the same field or class. This is not persuasive, since the groups are classified in different fields of search and will be burdensome (Class 252/518.1 for Group l and 423/594.4 for Group II).
- Claims 6-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b)

  The requirement is still deemed proper and is therefore made FINAL.
- The examiner has considered the IDS filed 04/14/2004.
- Acknowledgment is made of applicant's claim for foreign priority based on an application filed in China:
- Receipt is acknowledged of papers (CHN 03140216.X filed 08/15/2003 and CHN 03114242 filed 04/14/2003) submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. It is noted, however, that applicant has not filed a certified copy of the applications (CHN 03140196.1 filed 08/15/2003, CHN 03126555.3, filed 05/09/2003; CHN 03139607.0, filed 06/23/2003 and CHN 0310111966 filed 10/28/2003) as required by 35 U.S.C. 119(b).
- Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in CHINA, CHN 02151991.9 filed 11/19/2002 and CHN 02156241.5 filed12/10/2002. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Specification

The abstract of the disclosure is objected to because it has multiple paragraphs.

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The abstract should not exceed 25 lines of text. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102
Claim Rejections - 35 USC § 103

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
-

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rougier et al (Solid. St. Ion. 1996, V90, PP 83-90.

Rougier discloses an electrode material with the composition $LiNi_{0.9}O_{0.1}$ and its XRD pattern (Abstract; Pg 88, Fig-6; Pg-89, Cl-1, Para-2), that anticipates the elemental ratio in the claim because "[W]hen, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is anticipated' if one of them is in the prior art." <See MPEP 2131.03[R]>. The Intensity ratio of I_{003}/I_{104} of greater than 1.02 is anticipated from the XRD in Fig-1. All the limitations of the instant claim are met.

The reference is anticipatory.

In the alternative that the disclosure by Rougier et al be insufficient to anticipate the instant claims, the instant claimed composition nonetheless would have been obvious to a person of ordinary skilled in the art over the prior art disclosure and upon calculating the ratios from the Figure, and the burden is upon the applicant to prove otherwise. [MPEP 2112 [R-3-V].

2. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over, Matsubara (US 6,045, 771).

Matsubara teaches an electrode active material composition with the formula $Li_{y-x1}Ni_{1-x2}M_xO_2$; wherein M is Co or Mn, x, x1, and x2 represent $0<x\leq 0.5$, x1=0, and x2=x. The compound had had an (003)/(014) plane intensity ratio of 1.2 or higher. The secondary particles had a diameter of 5-100 micron and a primary spherical particle with a diameter of 0.2- 3 micron (Cl-3, Ln 17-63). The desired secondary particle size was 5-30 micron (Cl-5, Ln 33-36). The

compositions included $Li_{1.03}Ni_{0.97}Co_{0.03}O_2$ (Ex-14), $LiNi_{0.9}Co_{0.1}O_2$ (Ex-15, 20, 22), $LiNi_{0.8}Co_{0.2}O_2$ (Ex-16, 19), $LiNi_{0.7}Co_{0.3}O_2$ (Ex-17) that anticipates the elemental ranges in the claims. The XRD data in Fig 18 and 22, and the PSD in Fig 21 and 25 for Examples 14 and 16 respectively anticipates the intensity ratios and particle size and their ratios in claims 1-2 and 5. The prior art particles are either same or substantially same as that obtained by calcination and the formation of secondary particles by the aggregation of primary particles in claims-3 and 5 is anticipated during the heat treatment of the raw materials. The SEM data in Fig 19, 23 and 27 for Examples 14, 16 and 19 anticipates the shape in claims -4 and 5.

The reference is anticipatory.

In the alternative that the disclosure by Matsubara et al be insufficient to anticipate the instant claims, the instant claimed composition nonetheless would have been obvious to a person of ordinary skilled in the art over the prior art disclosure and upon calculating the ratios from the respective figures, and the burden is upon the applicant to prove otherwise [MPEP 2112 [R-3-V].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KALLAMBELLA VIJAYAKUMAR whose telephone number is (571)272-1324. The examiner can normally be reached on M-F 07-3.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 5712721358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KMV/
Feb 26, 2010.

/Stanley Silverman/
Supervisory Patent Examiner, Art Unit 1793